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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,389	06/28/2001	Michael Epstein	US 010313	6444

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EXAMINER	
ZAND, KAMBIZ	
ART UNIT	**PAPER NUMBER**
2132	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/894,389	EPSTEIN, MICHAEL	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 July 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

3/03/05

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/12/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-21** have been examined.

Information Disclosure Statement PTO-1449

2. The Information Disclosure Statement submitted by applicant on 11/12/2002 has been considered. Please see attached PTO-1449.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-21** are rejected under 35 U.S.C. 102(e) as being anticipated by Evans et al (WO 01/01316 A2) recited in applicant's IDS filed on 11/22/2002.

As per claims 1 and 12 Evans et al (WO 01/01316 A2) teach a security system, method (see title on page 1; line 1 on page 5) comprising: a verifier that is configured to determine an authorization to process protected material (see fig.8 block 808 where the verifier accept the payment and sending the decryption key for the protected material; examiner considers the accepting of the payment as determination of authorization and sending the decrypted key as authorization for processing the protected material), and a gate that is configured to: store a damaged version of the protected material while the verifier is determining the authorization (see fig.8, block 806; page 5, lines 3-10 where examiner considers the encrypted software as damaged content since without the decryption key is not usable; fig.4 ands associated text;), and repair the damaged version of the protected material to form a repaired version of the protected material after the verifier determines the authorization (the repair is being done by decrypting the encrypted content as disclosed on page 5, lines 3-25). Also see the entire reference for different variation of content protections under the same analogy that is providing a damage content (encrypted, scrambled, watermarked, etc.) to the client (user, client, server, entity,etc) and upon authorization (user authorization, payment authorization, license verification, etc.) repair the damage content by a decrypting key or descrambler key, etc.. to a usable content and where the downloading of the content or storing of the protected content is being done while the authorization is in process or before that process.

As per claims 2 and 13 Evans et al (WO 01/01316 A2) teach the security system and

the method of claims 1 and 12, wherein the verifier is configured to determine the authorization based on a verification of a presence of an entirety of a data set corresponding to the protected material (see page 5, lines 1-24; page 20, lines 8-12 and page 10, lines 10-14).

As per claims 5 and 16 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 1 and 12, wherein the gate comprises: a damager that is configured to damage a select portion of the protected material to form the damaged version, and a repairer that is configured to repair a corresponding select portion of the damaged version to form the repaired version (see fig.8 and page 1-5 where examiner considers the encrypted key corresponding to Applicant's damager; where encrypted content corresponds to Applicant's damage protected content; where decryption key corresponds to Applicant's repairer and where the decryption version corresponds to Applicant's undamaged or repaired protected content).

As per claim 6 Evans et al (WO 01/01316 A2) teach the security system of claims 5, wherein the gate is configured to disable the damager to prevent subsequent damage, after the verifier determines the authorization (see page 5; fig.8 where after determining the authorization such as payment acceptance by providing the decryption key for decrypting the encrypted software or protected content the act of disabling of the encrypted process is being done where the examiner considered the encrypted process as a damage process of protected content as applied to claim 1 above).

As per claims 11 and 21 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 1 and 12, wherein the gate is further configured to: provide an undamaged version of the protected material for rendering while the verifier is determining the authorization (see fig.8 and associated text).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) patent may not be obtained though the invention is not identically disclose or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 3-4 and 14-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Boebert et al (5,502,766).

As per claims 3 and 14 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 1 and 12, but do not disclose explicitly the gate is further configured to store the damaged version on a removable media. However Boebert et al (5,502,766) disclose storing the damaged version on a removable media (see abstract; fig.3 and associated text). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ebert's removable medium in evan's

software distribution system and method in order to provide a data enclave for securing data carried on a removable storage units (see col.5, lines 39-43).

As per claims 4 and 15 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 1 and 12, wherein the gate is further configured to store the damaged version, and store the repaired version in a permanent storage device as applied to claim 1 above but do not disclose storing the damaged version in a temporary storage device. However Ebert et al (5,502,766) disclose storing the damaged version in a temporary storage device (see fig.3 and associated text). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ebert's removable medium in evan's software distribution system and method in order to provide a data enclave for securing data carried on a removable storage units (see col.5, lines 39-43).

7. **Claims 7-10 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004.

As per claims 7 and 17 Evans et al (WO 01/01316 A2) teach all limitations of the claim as applied above but do not explicitly disclose a first device that is configured to damage the select portion of the protected material via an exclusive--or function with a key, and the repairer includes: a second device that is configured to repair the select

portion of the protected material via an exclusive--or function with the key. However Kubota (5,034,980) disclose a first device that is configured to damage the select portion of the protected material via an exclusive--or function with a key, and the repairer includes: a second device that is configured to repair the select portion of the protected material via an exclusive--or function with the key (see col.4, lines 46-66). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Kubota's XOR ciphering in Evan's software distribution system and method in order to implement simplest forms of coding (see col4, page 66-67).

8. **Claims 8-9 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004, and further in view of Boebert et al (5,502,766).

As per claims 8-9 and 18-19 Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) teach all limitations of the claim as applied above but do not explicitly disclose each the security system and the method of claims 7 and 17, wherein the key is provided via a random process and the key includes a series of random numbers that are provided via a pseudo-random process based on a key-seed. However Ebert et al (5,502,766) disclose the key is provided via a random process and the key includes a series of random numbers that are provided via a pseudo-random process based on a key-seed (see col.26, lines 43-55). It would have been obvious to one of ordinary skilled

in the art at the time the invention was made to utilize Ebert's random number key generation process in Kubota's XOR ciphering in Evan's software distribution system and method in order to implement more robust forms of coding.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004, and further in view of Hogg et al (4,281,216).

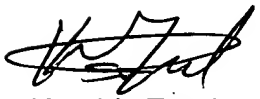
As per claims 10 and 20 Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) teach the security system and the method of claims 7 and 17 as applied above but do not disclose explicitly wherein the key is destroyed if the verifier fails to determine the authorization. However hog et al (4,281,216) disclose the key is destroyed if the verifier fails to determine the authorization (see col.12, lines 27-33). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Hogg's key destruction in case of unauthorized attempt in Kubota's XOR ciphering in view of Evan's software distribution system and method in order to prevent unauthorized access to the protected content.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

PLEASE SEE ENCLOSED PTO-892

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned as (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

03/03/2005

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